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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,890	01/23/2002	Yehouda Harpaz		8217

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EXAMINER

HOEL, MATTHEW D

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,890	HARPAZ, YEHOUDA	
	Examiner	Art Unit	
	Matthew D. Hoel	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments, see "Brief of Appeal," filed Aug. 23rd, 2004 and "Response to Examiner's Answer to Appeal Brief," with respect to the rejection(s) of Claims 3 and 4 under 102(b) and Claim 4 under 112, first paragraph have been fully considered and are persuasive. *Therefore, the rejections have been withdrawn.* The Board reversed the previous rejection of Claim 4 under 112, first paragraph on the basis that "Fillit" was adequately described on Pages 7 and 8 and in Fig. 4. The Board reversed the previous rejections of Claims 3 and 4 under 102(b) on the basis that the Blumberg device was programmed to play a variety of games, but not the specific game of Claim 3, and so there was "a structural difference over an unprogrammed general purpose computer or device" (Page 6). In other words, because the Blumberg device was not programmed to play the game of Claim 3, it was not structurally equivalent and could not anticipate all of the structural elements of Claim 3. The examiner agrees with the Board's decision. See MPEP 2106. However, upon further consideration, new grounds of rejection made are in view of double patenting and 112, second paragraph. *Introducing terminal disclaimers and rewriting the claims to remove 112 issues without introducing new matter to the claims will put the application in condition for allowance.*

Oath/Declaration

2. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on applications 9919551.3 and 9929210.4 filed in Great Britain on Aug. 19th, 1999 and Dec. 13th, 1999, respectively. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. The PCT application PCT/GB00/02586 (WIPO publication WO 01/14025) is listed in the oath, but the applications 9919551.3 and 9929210.4 that it claims priority to are not. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Priority

3. Claim 3 is given a priority date of Aug. 19th, 1999. This application is drawn to the "Fillit" game. The certified copies of foreign priority applications 9919551.3 and 9929210.4 mention the game "Fillit" (Pages 2, 3, 9), but they do not describe the rules of "Fillit" in detail, and so do not enable the detailed rules of "Fillit" claimed in Claim 4. The examiner also notes that these documents do not have the detailed descriptions of "Fillit" found in Pages 7 and 8 and Fig. 4 of the specifications of PCT/GB00/02586 and present application 10/031,890. Claim 4 is enabled by PCT/GB00/02586 and is given a priority date of July 5th, 2000. The descriptions of Pages 7 and 8 and Fig. 4 were relied upon by the Board to overturn the 35 U.S.C. § 112, first paragraph rejection of Claim 4 in the final rejection of May 14th, 2004. The examiner agrees with the Board's decision.

Double Patenting

4. The examiner notes that the applicant has applications 10/069,491; 10/069,505; 10/069,833; 10/069,834; and 10/069,835 pending for similar inventions. These applications are undergoing initial processing and have not been scanned into IFW/Public PAIR yet. Double-patenting rejections were also made in 10/031,776 and 10/032,942. The Office will be watching these other applications for double-patenting issues.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where

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the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 3 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 6,568,683 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors. Claim 3 of the present application cites in part: "An electronic board comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and an illumination source inside or below the surface which is capable of illuminating the visible element by either of two colours..." Claim 1 of '683 cites in part: "An electronic board comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed,

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and can be illuminated in two different colours by an illumination source inside or below the surface...”

9. Claims 3 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application No. 10/031,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors. Claim 1 of '776 cites in part: “An electronic board comprising: a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and can be illuminated in two different colours, allocated to respective players, by an illumination source inside or below the surface...”

10. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 3 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 5 of copending Application No. 10/031,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors. Claim 5 of '942 cites in part: “An electronic board comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and an

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illumination source inside or below the surface which is capable of illuminating the visible element by either of two colours...”

12. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 3 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application No. 10/497,428. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors. Claim 1 of '428 cites in part: “An electronic board-games board for playing games comprising a grid of grid points on a flat surface, where each grid point is a visible element which is capable of detecting when it is pressed, and can be illuminated in three different colours, where in at least one game the behaviour of the board is as follows: two colours are player-colours, and one is neutral...”

14. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Terminal Disclaimer

15. Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

16. Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

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17. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

18. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

19. The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

20. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

21. The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

22. Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end MPEP § 1490.

Specification

23. The disclosure is objected to because of the following informalities: On Page 1, "...approximately once a *weak*..." should be "approximately once a *week*..." On Page 2, "...the games manager *3controls*..." should be "the games manager *controls*..." On Page 4, "...where each move *involve*..." should be "where each move *involves*..." On Page 5, "...never *change* unilluminated points..." should be "...never *changing* unilluminated points..."

24. Appropriate correction is required.

25. The format of the specification was informal, but did not preclude examination. The following format is suggested for future applications, as it will expedite quick prosecution.

Content of Specification

Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were

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permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claims

26. The examiner notes the corrections made to the following informalities: the claims as amended on Jan. 23rd, 2004 cite cancelled Claims 1 and 2, and new Claims 1 and 2. The amended claims of Mar. 9th, 2004 cite new Claims 3 and 4. Thank you for the corrections.

27. Claim 4 is objected to because of the following informalities: "...the other player's colour." should read "...the other player's colour." A claim should read as a complete sentence with a period only at the end. Appropriate correction is required.

Claim Rejections - 35 USC § 112

28. The following is a quotation of the second paragraph of 35 U.S.C. 112:

29. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

30. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to Claims 3 and 4: Claims 3 and 4 recite the limitations "the current player," "the player," and "the other player." There is insufficient antecedent basis for these limitations in the claims, although they are supported by the specification. Claim 3 in the seventh line refers to "the current player" without previously citing "a current player." Claim 3 correctly refers to "the board" in the sixth line after previously citing "an electronic board" in the first line. The claims preferably should read "a first player," thereafter referred to as "the first player" or "said first player," and "a second player," thereafter referred to as "the second player" or "said second player." The examiner understands what the applicant is saying based on the specification, but the claims are confusing when read by themselves. Appropriate correction is required. The applicant is reminded not to positively cite a player (a human being) as being part of a system or apparatus as this would result in a rejection for non-statutory matter under 35 U.S.C. § 101. Suggested language for Claim 3 would be: "the board being configured such that: when a player presses a grid point..." instead of "when a player presses a grid point..." This language would properly cite the electronic board as being able to

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accept input from a player without citing the player as part of the claimed system or apparatus.

Conclusion

31. The applicant is commended on his persistence and well thought out arguments. The examiner has found no prior art that reads on the "Fillit" game claimed in Claims 3 and 4 and believes the invention is novel and non-obvious and would be in condition for allowance once the claims are rewritten.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner
AU 3713



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TC370